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Assistant Commissioner for Patents, Washington, D.C. 20231, on November 14, 1997

Tiffany E. Montgomery
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Walter L. Miller et al.

Serial No.: 08/487,312

Filing Date: 7 June 1995

For: BOVINE GROWTH HORMONE

Examiner: C. Saoud

Group Art Unit: 1801

RESPONSE TO COMMUNICATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is in response to a Communication mailed 10 November 1997, time for response to which was set to expire 10 January 1998. The Communication indicates that the Reply Brief filed 15 October 1997 was not entered. Appellants respectfully request reconsideration and entry of the Reply Brief.

Two reasons were given for this refusal. The first was that "The identification of Interference no. 103,925 is inappropriate." Appellants do not understand this rationale. 37 CFR 1.192 which sets forth the requirements for Appellants' Brief mandates a statement identifying by number and filing date all other appeals or interferences that "have a bearing on the Board's decision in the pending appeal." Presumably, this requirement is included because the Board wants to know about such related interferences. While the present appellants cannot be certain

that Interference No. 103,925 will, indeed, have a bearing on the Board's decision in the pending appeal, it is certainly a related matter as the subject matter concerns recombinant materials for the preparation of the claimed bovine growth hormone. Although the present claims were separated from the claims in Interference by virtue of a restriction requirement, appellants note that this restriction was not made in U.S. Serial No. 08/457,519, the application of appellants' opponent in the Interference.

The Interference had not been declared at the time appellants' Brief was filed, so it could not have been included in the original Brief. It would be illogical to conclude that a matter judged sufficiently important to mandate its notice in the original Brief would suddenly be of no interest because it materialized between the time of filing of the original Brief and the filing of the Reply Brief. Appellants believe it unfair to refuse entry of their Reply Brief on the basis that they have endeavored to provide full disclosure to the Board on this matter.

The second basis relates to the issue of FDA regulations. This issue was, indeed, raised in the appellants' original Brief. It was, indeed, addressed by the Examiner in the Answer. This, however, is the first time this argument has been addressed by the Office. Therefore, in appellants' view, this qualifies as a new point of argument raised in the Examiner's Answer, as set forth in 37 CFR 1.193. Appellants have not previously had an opportunity to respond to the position of the Office on this issue. Accordingly, the response in the Reply Brief is believed appropriate.

Based on the foregoing, entry of the Reply Brief is respectfully requested.

Dated: November 14, 1997

Respectfully submitted,

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